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REMARKS

In the above-referenced Final Office Action, the Examiner rejected claim 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter that applicant regards as the invention; rejected claims 1-4, 7, 11, 12, 14-16, and 18 under 35 U.S.C. § 102(a) as being anticipated by Eppard et al. (U.S. Patent No. 6,726,163); rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Eppard et al. in view of Devall (U.S. Patent No. 5,723,808); rejected claims 1-4, 7, 11, 12, 14-16, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Eppard et al. in view of Simonek (U.S. Patent No. 5,974,719); rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Eppard et al. in view of Peterson (U.S. Patent No. 6,637,708); rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Eppard et al. in view of Devall and Potts et al. (U.S. Patent No. 6,425,697); and indicated that claims 8-10 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In this Amendment, Applicant has amended claims 2-5, 7-8, 10-12, 16-17, and 19; cancelled claims 1 and 18; and added claims 20 and 21. Claims 2-5, 7-17, and 19-21 are currently pending. Amendments to claims 2-5, 7-11, and 16-17 are to change dependency of the claims. Claim 11 has been amended to clarify the projection attachment. These amendments are not related to patentability, as they are not related to any rejection or elements that are present in claim 21, added in this amendment. Thus, these claims are not

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subject to limitations on their scope. Applicant has added new claims 20 and 21 to further define the invention.

The Examiner rejected claim 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter that applicant regards as the invention. The Examiner alleged that the phrase "an arm configured to be" is vague and indefinite since it is unclear if it is attached or merely configured to be as a possibility, but that no attachment means have been recited. This, according to the Examiner, appears to be required element for a system to function.

Applicant has claimed only a portion of a complete system in claim 19 and asserts that he is entitled to claim only a portion of a system, provided that the claims directed to that portion meet all of the statutory requirements for patentability. While Applicant believes that the claim as previously presented satisfies the statutory requirements, Applicant has amended the claim to make this more clear. Specifically, Applicant has limited the preamble to a firearm support, and believes that this should resolve the Examiner's concerns.

Applicant would also point out to the Examiner, to the extent that the phrase "configured to be" may still be considered inadequate, that the same phrase is present in claim 12, which was not rejected in two Office Actions by the Examiner. Thus, Applicants assert that this phrase is not vague, given the circumstances of the present Amendment.

The Examiner then rejected claims 1-4, 7, 11, 12, 14-16, and 18 under 35 U.S.C. § 102(a) as being anticipated by Eppard et al. Applicant has canceled claim 1 and added new claim 21, from which the claims that formerly depended on claim 1 now depend.

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Applicant has added new claim 21, but maintains that the prior amended claim 1 was allowable over the prior art. The Examiner alleged that the element 151 would meet the limitation of a "rest member" since there is no structure claimed to distinguish over that element. However, Applicant asserts that the element 151, which is a spring cord stop, is not a rest member for supporting a firearm and, even if it could function in that regard, the real rest member 20 would be in the way of the hunter trying to sight the firearm. Additionally, the reference by its own disclosure eliminates the need for multiple rests. As noted in the Eppard et al. Abstract: "Vertical aiming adjustment is allowed by swinging the firearm forward or backward within the cradle and/or adjusting the cradle along the fore-end of the stock of the firearm." The Eppard et al. specification elaborates even more on this particular point at col. 3, lines 43-48. The reference also provides an alternative method for vertical adjustment (see, e.g., Fig. 7): "Vertical sight adjustment can further be modified by adjusting the length of the cord securing the cradle to the respective forks as specifically provided herein." Col. 3, lines 48-52. Thus, there is no need for a plurality of rest members in Eppard et al. as the reference solves the Examiner's alleged problem. However, Applicant has decided to add new claim 21 to move prosecution along.

New claim 21 requires, inter alia, that the support element is attached to and extends from the at least one end of the arm and has a predetermined fixed length extending therefrom. The preferred embodiment of the support in Eppard et al. (see Fig. 1) does not have a predetermined fixed length extending from the extendable arm. Rather, the cords that

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extend from the forks 16,18 are adjustable so that the length that extends from the arms is also adjustable.

The embodiment in Fig. 7 does indicate that the length of the cords may be fixed. However, when the cord length is fixed in Eppard et al., then the cradle 20 is adjustable along the cords. See, e.g., col. 8, lines 34-45. New claim 21 also requires, inter alia, that the plurality of rest members be fixedly attached to the support element. When the cords are fixed in Eppard et al., the cradle is movable and vice versa. To the extent that the cords could be fixed and have a plurality of rest members, Applicant asserts that Eppard et al. would have added such an embodiment at the time if it were so obvious and desirable. Thus, the firearm support system of new claim 21 is allowable over Eppard et al.

Claims 2-5 and 7-11, which depend from allowable claim 21, are now allowable for at least the same reasons.

Amended independent claim 12 requires, inter alia, that the support element be attached to and extend from the at least one end of the arm and have a predetermined fixed length extending therefrom and that there be a plurality of rest members that are fixedly attached to the support element. As noted above with respect to new claim 21, Eppard et al. fails to disclose or suggest a firearm support system that has both of those elements. Thus, amended claim 12 is also allowable.

Claims 14-16, which depend from allowable claim 12, are also allowable for at least the same reasons.

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New claim 20 requires that the extendable arm have a single terminus, that two support elements be attached to the extendable arm, and that a plurality of rigid rest members be attached to each of the support elements. Eppard et al. does not have an extendable arm with a single terminus. Rather, the device in Eppard et al. must have forks in order to perform its function because the cradle is made of "any suitable flexible material" and without the forks providing a separation of the cords and the cradle, the hunter would have a difficult, if not impossible, time in inserting the firearm on the cradle between the cords.

New claim 20 also requires that the rest members, of which there are a plurality, also be rigid. As noted above, the cradle of Eppard et al. is of "any suitable flexible material." Additionally, Eppard et al. does not disclose a plurality of rest members. Contrary to the Examiner's assertion that the spring cord stop 151 may function as a rest member, it does not and cannot for the reasons mentioned above. For these additional reasons, new claim 20 is also allowable.

The Examiner then rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Eppard et al. in view of Devall. The Examiner indicated that Eppard et al. discloses everything in the claim but the extendable arm that comprises pivoting arm segments. Office Action at p. 3. The Examiner then alleged Devall teaches that it is known to have pivoting arm segments from the extendable arm of a tree mounted firearm support. Office Action at p. 3. The Examiner also alleged that the motivation of such a "mere substitution" is the advantages of increased positioning function available with the plural pivoting elements. Id. The rejection of claim 5 must be withdrawn for at least three reasons.

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First, the two references do not disclose or suggest the claimed invention, alone or in combination. New claim 21, the claim from which claim 5 depends, is allowable over Eppard et al. for the reasons noted above and which will not be repeated here, and Devall does not cure those deficiencies of Eppard et al. For this reason alone, the claim is allowable.

Second, the combination of the two references is physically impossible. As noted above, the cord 23, which supports and controls the height of cradle 20 in one embodiment, passes through the y-shaped connector 14 and horizontal member 78. Applicant cannot understand how the cord 23 in Eppard et al., which is relied upon by the Examiner, can be maintained inside the arm and still allow for variation in the height of the cradle 20 when combined with the pivoting arm segments of Devall. The pivoting of the arm would interfere with the movement of the cord. In order to combine these references, the devices in both references would have to be reconstructed in order to work as required by the claim.

Third, and very importantly, the Examiner has failed to provide any motivation for combining the references and therefore has failed to establish the required prima facie case of obviousness. The Examiner's unsupported statement that the motivation to combine is "the mere substitution of known extendable arm, with the advantages of increased positioning function available with the plural pivoting elements. To employ the teachings of Devall on the firearm support system of Eppard et al and have pivoting arm segments is considered to have been obvious to one having ordinary skill in the art" is insufficient to carry this burden. Office Action at p. 3. In order to carry that burden, the Examiner must provide factual bases

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for the motivation of the combination, and a mere assertion that one of ordinary skill in the art would do so was counseled against by the Federal Circuit as being clearly improper for failing to provide factual basis for the motivation. See, e.g., In re Lee, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) (“Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.”). In fact, the reasoning given in the present Office Action is eerily similar to that which was rejected by the Federal Circuit in In re Lee.

Furthermore, Applicant asserts that the Examiner is using impermissible hindsight and has taken what has been taught by the invention and stated that it would be obvious to combine the two references without any factual basis. See, e.g., W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. (BNA) 303, 312-13 (Fed. Cir. 1983) (cautioning against the “insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”).

Moreover, as noted above, Eppard et al. provides for an increased positioning function with the telescoping portion and thus one of ordinary skill in the art would not look to other references for such a feature. In fact, Applicant asserts that such a configuration teaches away from combining the two references since there is a solution to the alleged problem raised by the Examiner. Thus, this claim is allowable over the references for these reasons.

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Applicant notes that this rejection is the very same rejection that was used in the prior Office Action. Applicant responded at length to that rejection and provided several reasons that the rejection was improper or incorrect. The Examiner failed to indicate why those arguments were not persuasive and Applicants request that the Examiner, pursuant to MPEP § 707.07(f), provide the reasons that the arguments, which are again provided here, are not persuasive if the Examiner finds that they are not persuasive again.

The Examiner then rejected claims 1-4, 7, 11, 12, 14-16, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Eppard et al. in view of Simonek (U.S. Patent No: 5,974,719). The Examiner alleged that Eppard et al. shows all of the features of the claimed invention and that if it were argued that Eppard et al. does not disclose a plurality of rest members spaced from one another then Simonek discloses a plurality of rest members. The Examiner alleged that the motivation was to "allow shooting from different positions (c.g., standing and kneeling)." Office Action at p. 4. The Examiner then alleged that Simonek is used only for the concept that gun rests at a plurality of heights for the convenience of the user, not the particular rests in Simonek and that the addition of additional rests would be those of Eppard et al.

Again, the Examiner ignores the fact that Eppard et al. already solves the problem that the Examiner is alleging to exist. Eppard et al. has multiple solutions for height adjustment. For example, the Abstract indicates:

Vertical aiming adjustment is allowed by swinging the firearm forward or backward within the cradle and/or adjusting the cradle along the fore-end of the stock of the firearm.

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At col. 2, lines 48-54, Eppard et al. indicates that

A further primary object of the invention is to provide a hunter's shooting rest that allows for unhindered and continuous horizontal and vertical sight adjustment when aiming a firearm supported thereby.

Another object of the invention is to provide an effective method of supporting and aiming a firearm from a tree stand, a tree seat, a ground blind or a field.
(emphasis added)

Then again at col. 3, lines 43-60:

Once the firearm is in place within the cradle, adjustment of vertical sighting is easily effected by rocking the firearm forward and/or sliding the cradle forward on the fore-end of the stock or barrel for longer shots and rocking the firearm backward and/or sliding the cradle rearward on the fore-end of the stock or receiver for shorter shots. Vertical sight adjustment can further be modified by adjusting the length of the cord securing the cradle to the respective forks as specifically described hereinafter.....Thus, smooth and continuous aiming at game in the vertical plane and the horizontal plane is allowed by maneuvering the firearm within the cradle without having to directly adjust the shooting rest itself.

Thus, Applicant asserts that one of ordinary skill in the art would not be looking for other ways to address the height issue.

Additionally, Applicant is not sure how additional supports would be added given the configuration and attachment of the rests in Eppard et al. Applicant asserts that there would have to be reconstruction of the cords, cradle, etc. to accommodate more cradles, even assuming that more were desirable.

As a result, Applicant asserts that the combination of these two references were done with impermissible hindsight and the rejection must be withdrawn.

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The Examiner then rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Eppard et al. in view of Peterson. The Examiner relied on Eppard et al. as noted above and indicated that it failed to disclose that the fixed structure is a tree stand, but that Peterson discloses attaching a firearm support system to a tree stand. As also noted above, Eppard et al. does not disclose or suggest the invention claimed in new claim 21, the claim from which rejected claim 17 now depends. The disclosure of Peterson (i.e., attaching an aiming support to a tree stand) does not cure the deficiencies noted above with respect to claim 21. Therefore, claim 17 is allowable for at least this reason.

The Examiner then rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Eppard et al. in view of Devall and Potts et al. The Examiner alleged that Eppard et al. discloses a firearm support system comprising a telescopic extendable arm 94, a flexible support element 22 attached to the extendable arm, rest member 20 connected to the support element, and a pivoting support attachment member 10 that accepts a portion of the extendable arm and is attached to a fixed structure. Office Action at p. 5. The Examiner admitted that Eppard et al. fails to disclose that the extendable arm could comprise a rounded portion with threads to engage the support structure, but that Devall teaches a pivoting extendable arm of a tree mounted firearm support having a rounded portion that is attached within the tube of an attachment member. Id. However, the Examiner then admitted that Devall fails to teach the round portion includes threads to engage the support structure. Id. The Examiner then cited Potts et al. for the proposition that it teaches threads on the end of a gun rest to secure the arm to the support element. Id.

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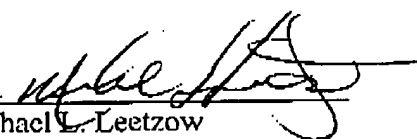
Again, the Examiner recited the very same rejection without any comments regarding the Applicant's arguments. Applicant again requests that the Examiner provide the required commentary if the Examiner again finds the following arguments unpersuasive.

The citation of the three references to render the invention in claim 13 obvious is clearly a product of impermissible hindsight by the Examiner. While this reason alone provides sufficient reason to require a withdrawal of the rejection, the combination of the references fails to disclose or suggest the claimed invention even if hindsight were not used. The Examiner cited element 16a for the proposition of using threads to secure the arm to a support element. Office Action at p. 5. The purpose of the invention in Potts et al. is to provide a camera mounting assembly for a firearm. The Potts et al. device provides a mechanism to allow a camera to capture the shooting by the firearm by maintaining a camera focused on the direction of the firearm. The device does not disclose or suggest the use of threads to secure the arm to a support element as alleged by the Examiner. Rather, the element noted by the Examiner, element 16a of Potts et al., is an upper portion of swing arm 16, which is used to connect the firearm mount 12 and the camera support 18 to one another. Furthermore, the other two references, alone or in combination, do not disclose or suggest the remaining elements of the invention claimed in claim 12, the claim from which claim 13 depends, and claim 13 is allowable for this reason alone.

Applicant has added two new independent claims, cancelled two independent claims, thus necessitating no new fees. No fees other than those provided for (RCE Request) are believed to be due in connection with the filing of this response.

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